Supreme Court, U. S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

No. 77-1

ERICH F. MEITZNER AND JAMES A. OLINE,
Petitioners,

v.

MORRIS MINDICK AND JERRY J. SVARZ,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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Petitioners pray that a writ of certiorari issue to review the decision of the United States Court of Customs and Patent Appeals (CCPA) entered in the above-identified case.

CITATIONS TO OPINIONS BELOW

The opinion of the Board of Patent Interferences (hereafter the "Board") of the United States Patent And Trademark Office (PTO) is printed in the Appendix hereto (App. 1a) and has not been reported. The opinion of the CCPA is printed in the Appendix hereto (App. 32a) and is reported at 549 F.2d 775 (CCPA 1977).

JURISDICTION

The decision of the CCPA was made February 24, 1977 and Meitzner et al.'s timely petition for rehearing was denied on April 28, 1977 (App. 49a). The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1256.

QUESTION PRESENTED

May the PTO properly grant a patent to one who it has determined is not the first inventor, where there has been no abandonment, suppression or concealment by the first inventor?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

A. That portion of Article 1, Section 8 of the Constitution of the United States of America reproduced below is involved:

> "Section 8. The Congress shall have Power . . . .
>
> To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;"

B. Congress has legislated this Constitutional sanction in part, by Sections 135(a) and 102(g) of Title 35, United States Code reproduced below:

> Section 135. Interferences.
>
> (a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences)

whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and *the Commissioner may issue a patent to the applicant who is adjudged the prior inventor.*[1] A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent and Trademark Office.

Section 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

* * * *

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. (Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501.).

STATEMENT OF THE CASE

This petition seeks to review the decision of the CCPA affirming the decision of the Board awarding priority in an interference as to Counts 1-4 to Mindick et al. Jurisdiction of the CCPA was based on 35 U.S.C. § 141. The Board also found

". . . that we would award priority, based on proofs alone, as follows: (1) counts 1-4 to Meitzner . . ."

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[1] Emphasis supplied.

This finding that, *based on the proofs*, Mindick et al. was not the first inventor was not disturbed by the CCPA. Mindick et al. has not challenged the finding but has contended that another inventor entity, not a party to the proceeding, is the first inventor. Mindick et al. made no allegation that Meitzner et al. abandoned, suppressed, or concealed the invention and neither the Board nor the CCPA made any finding on this matter.

Even though they have been found not to be the first inventor, Mindick et al. will be allowed to continue to claim in their patent the subject matter of Counts 1-4 and to force the public, including the first inventor, Meitzner et al. to pay tribute to it.

REASONS FOR GRANTING THE WRIT

1. To Resolve The Conflict Between The Decision Below And The Decisions Of This Court

This Court laid down as the fundamental rule that "the patentee must be the first inventor" in *Alexander Milburn Company* v. *Davis-Bournonville Company*, 270 US 390, 402, 70 L. Ed. 651 46 S. Ct. 324, 1926, cited by this Court with approval in *Detrola Radio and Television Corporation* v. *Hazeltine Corporation*, 313 US 259, 265, 85 L. Ed. 1319, 61 S. Ct. 948, 1941, 490 USPQ 337, and *Hazeltine Research, Inc. et al.* v. *Brenner, Commr. Pats.*, 382 US 252, 254, 15 L. Ed. 2d 304, 86 S. Ct. 335, 1965, 147 USPQ 429. The following decisions of this Court are to the same effect: *Gayler* v. *Wilder*, 51 US 477, 13 L. Ed. 504 (1850); *Evans* v. *Eaton*, 16 US 454, 4 L. Ed. 433 (1818); *Hayden* v. *Suffolk Mfg. Co.*, F Case No. 6,261, CC Mass. (1862), aff'd. 70 US 315; 18 L. Ed. 76 (1886); *Coffin* v. *Ogden*, 85 US 120, 21 L. Ed. 821 (1874); *Radio Corp.* v. *Radio Eng. Lab.*, 293 US 1, 3, 79 L. Ed. 163 (1934).

The Board has held, based on the proofs, that Meitzner et al. is the first inventor of Counts 1-4. This finding

has not been disturbed by the CCPA and thus is the law of the case. The only statutory basis for issuing a patent to one found not to be the first inventor is, as set forth in 35 U.S.C. 102(g), that the first inventor has "abandoned, suppressed, or concealed it." No such finding has been made, nor would such finding be appropriate.

Meitzner et al., the first inventor, duly filed a patent application on their work. Steps were diligently taken by Meitzner et al. to commercialize the invention emanating from it and Meitzner et al. provided to the public as quickly as possible (less than a year after filing for patent) the benefits and advantages springing from their work. In contrast, Mindick et al. kept their invention pending in secrecy in the PTO for a full decade and more before offering the public any disclosure of the invention or any advantages or benefits that might derive from it.

In awarding priority to Mindick et al., both the Board and the CCPA relied solely on a "doctrine of estoppel" which has no statutory, regulatory or Constitutional basis for an award of priority to one who is not the first inventor and which conflicts with the decisions of this Court. Irrespective of whether such a doctrine would be sufficient to deny a patent to the first inventor, it is clear that, absent some statutory foundation, it cannot serve as the basis for awarding a patent monopoly to one who has been found by the PTO not to be the first inventor.

As set forth in the statute, an award of a patent to one not the first inventor can be made only if the first inventor has "abandoned, suppressed or concealed" the invention. Since that is not the case here, the decision of the CCPA must be reversed. The overwhelming interest of the public in seeing that a patent monopoly is not improvidently granted transcends the interests of the individual parties. If the proofs determine, as they do, that Mindick et al. are not the first inventors, then

under the statute Mindick et al. are not entitled to the patent. If, because of an estoppel, Meitzner et al. are not entitled to the patent even though found to be the first inventors, then they are entitled to an award of priority, but their claim to a patent should be rejected in *ex parte* prosecution in the PTO. A patent monopoly is not a plum to be awarded to one found not to be the first inventor merely because the true first inventor may be subject to a technical estoppel.

Any member of the public wishing to litigate the Mindick et al. patent would face an unusually heavy burden. While the courts normally accord a presumption of correctness to the findings of an administrative tribunal, that presumption is especially strong when, as here, it arises in the context of an *inter partes* proceeding wherein precisely the same issue is before the administrative tribunal as before the court. Thus, in *Corometrics Medical Systems, Inc.* v. *Berkeley Bio-Engineering, Inc.*, —— F.Supp. ——, 193 USPQ 467, 474 (DC, N.D., Cal.) 1977, the court stated:

> "The presumption of patent validity is here further strengthened in view of the extraordinary Inter Partes protest proceeding in Hon et al, reissue patent application Serial No. 547,716 wherein all of the contentions now raised by defendant were rejected by the Patent and Trademark Office."

The overriding interest of the public in free competition was stated by this Court in *Lear* v. *Adkins*, 395 US 653 (1969). A Department of Justice official has succinctly expressed that policy:

> "An invalid patent is a much greater threat to competition than any of the restrictions to which I referred, since any anticompetitive restrictions which we might countenance to encourage innovation in the case of a valid patent becomes unlawful if our assumption of a valid patent is incorrect. As Judge

> Frank of the Court of Appeals for the Second Circuit once stated, 'an invalid patent masquerading as a valid one is a public menace. . . .'' [Speech by Richard W. McLaren, Patent Licenses and Antitrust Considerations, given June 5, 1969 before the PTC Research Institute of George Washington University].

2. To Determine Whether The PTO Can Issue A Patent To One Found By The PTO Not To Be The First Inventor

The sole reason for the award of priority to Mindick et al. by the Board and the CCPA on Counts 1-4 was that Meitzner et al. were held to be estopped by reason of their conduct in an earlier interference. As a result, the CCPA held:

> "We agree with the Board that there is estoppel against Meitzner from claiming the subject matter of the present counts."

Based solely on this conclusion the Court then decided:

> "The decision of the Board awarding priority to Mindick et al. on Counts 1-10 is affirmed."

Essentially, the decision of the CCPA is an intuitive application of the doctrine of estoppel—i.e., if Meitzner et al. can't have the counts, then, *a fortiori*, Mindick et al. must be entitled to them. Such a decision has no basis in the statutes or in the rules or regulations of the PTO.

Decisions bottomed on estoppel often reflect a lack of reasoned consideration of the basic issues involved. Estoppel becomes a talismanic word enabling the court to leap from premise "A" (Meitzner et al. "estopped" to obtain patent) to conclusion "B" (Mindick et al. entitled to receive patent) without consideration of whether such a conclusion does follow and without consideration of the interest of the public. As observed by this Court:

> "While the roots of the doctrine have often been celebrated in tradition, we have found only one 19th century case in this Court that invoked estoppel in a considered manner." *Lear, Inc.* v. *Adkins*, 395 US 653, 663 (1969).

While the court in *Lear* was discussing "licensee" estoppel, the same lack of detailed consideration is shown in the instant case with respect to "junior party" estoppel involved herein—and with the same substantive effect, i.e., in the one case a potentially invalid patent is shielded from attack, in the other a patent which under 35 U.S.C. 102(g) would be invalid is issued and its presumption of validity strengthened. In the case of any patent, the public interest is paramount to that of the individual parties since it is the public which is subject to the monopoly granted by the patent.

Both the statutes enacted by Congress and the decisions of this Court mandate that the patent monopoly is to be granted only to the first inventor unless he has "abandoned, suppressed or concealed" the invention. A finding of estoppel, even when warranted, against one found to be the first inventor, who has not abandoned, suppressed or concealed, affords no basis for awarding the patent to another. As stated by this Court:

> "Surely the equities of the licensor do not weigh very heavily when they are balanced against the important public interest in permitting full and free competition in the use of ideas which are in reality a part of the public domain." *Lear, Inc.* v. *Adkins*, 395 US 653, 670 (1969).

Substitute "senior party Mindick et al." for "licensor" and the doctrine stated compels granting the instant petition.

It is respectfully submitted that the CCPA has misapprehended the applicability of the doctrine of estoppel

by awarding priority to one who is not the first inventor in a situation where no abandonment, suppression or concealment has been found. The result has been to burden the public with an invalid and unnecessary patent.

CONCLUSION

For the foregoing reasons this Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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